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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09 944,497	08.31.2001	Mohan Ramachandra Wani	A34628; 066123.0109	2639

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NEW YORK, NY 10112

EXAMINER

WINSTON, RANDALL O

ART UNIT	PAPER NUMBER
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1654

DATE MAILED: 12/17/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

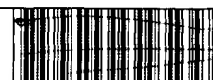
Office Action Summary

Application No.
09/944,497

Applicant(s)
Ramachandra et al.

Examiner
Randall Winston

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1654



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-35 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other: _____

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DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-7, drawn to a composition comprising mussel hydrolysate from Indian green mussel and at least one additive, classified in class 424, subclass 547, for example.
 - II. Claim 8, drawn to an extract of Indian green mussel comprising mussel hydrolysate, classified in class 424, subclass 93.7, for example.
 - III. Claims 9-20, drawn to a method of inhibiting osteoclast formulation, classified in class 424, subclass 93.7, for example.
 - IV. Claims 21-30, drawn to a method of inhibiting bone resorption, classified in class 424, subclass 520, for example.
 - V. Claims 31-35, drawn to a process for extracting mussel hydrolysate at particular ranges and/or temperature and/or time and/or method of incubating vs. isolating, classified in class 424, subclass 520, for example.
2. The inventive groups above are directed to different inventions which are not connected in design, operation, and/or effect. These methods (Inventions III, IV and V, a method of inhibiting osteoclast formulation, a method of inhibiting bone resorption, and a process for extracting mussel hydrolysate at particular ranges and/or temperature and/or time and/or method of incubating vs. isolating are distinguishable, each from the other, because each of applicants' methods have a different effect (i.e. applicant utilization of a similar method for Invention III and

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IV will not inherently cause a similar result in Inventions III and IV whereas one invention inhibits osteoclast formulation and the other inhibits bone resorption. Moreover, the preparatory process of Invention V is distinguishable from the Inventions III and IV because each of applicant's processes has a different mode of operation. The compositions of Inventions I and II are distinguishable, each from the other, because the compositions comprise different active ingredients. Further, Invention I is a composition and Invention II is an extraction of a composition. Thus, the above inventions are distinct since they are not disclosed as capable of use together, they have different modes of operation, they have different functions, and/or they have different effects. In addition, one would not have to practice the various methods and/or use the various compositions at the same time to practice just one method alone and/or one composition alone.

3. The several inventions above are independent and distinct, each from the other. They have acquired a separate status in the art as a separate subject for inventive effect and require independent searches (as indicated by the different classification). The search for each of the above inventions is not co-extensive particularly with regard to the literature search. Further, a reference which would anticipate the invention of one group would not necessarily anticipate or even make obvious another group. Finally, the consideration for patentability is different in each case. Thus, it would be an undue burden to examine all the above inventions in one application.


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Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirements be traversed (37 CFR 1.143).

Any inquiry concerning this communication should be directed to Randall Winston at telephone number (703) 305-0404. The examiner can normally be reached during the hours of 08:30 to 17:00 Eastern.

If attempts to reach the examiner by telephone are unsuccessful. A message may be left on the voice mail. The fax number the Art 1654 is (703) 308-4242 or 305-3014. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196. My supervisor, Brenda Brumback, may be contacted at (703) 306-3220.

Randall O. Winston
Examiner, 1654


OFFICE OF THE EXAMINER
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